

Application No. 09/761,112  
Amendment dated October 10, 2006  
After Final Office Action of August 9, 2006

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### **REMARKS**

Claims 1–49 are pending and have all been finally rejected based variously upon a new grounds of rejection under 35 USC Section 103, in view of one or more of Novikov et al., and Teitelbaum. Additionally, claims 47 and 48 have been rejected under 35 USC Section 101 as being non-statutory. The undersigned respectfully requests reconsideration of the finality of this rejection as well as withdrawal of the rejection and allowance of the claims as pending.

#### ***Cited References:***

Novikov et al. -

“The Novikov invention relates to a system and method for biometric input, comparison, and authentication and, more particularly, to a biometric input device having a scanning window with a ridge structure, illuminated prism, an image detector and scanning electronics operable in conjunction with biometric data comparison system for comparing directional and minutia data. The biometric data comparison system provides for controlled access to a computing system based upon comparison of inputted biometric data with biometric data stored in a database. The system and method of the present invention further provides for secure communication of biometric data over public lines.” – See, for example, the Background section of the Novikov et al. reference.

As noted, this invention provides for controlled access to a computing system using biometric data – however the system evaluating and determining the access is the very same system that receives the biometric data. The system is thus operational prior to testing the biometric data.

Teitelbaum

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"This invention relates generally to telephones and more particularly to a telephone provided with a contact imaging device for identifying an operator of the telephone." – See, for example, Field of the Invention section of the Teitelbaum reference

As noted, this invention provides a biometric reader in cooperation with an active telephone system – controlling access to features of the telephone.

***Arguments:***

- I. The Finality of the Rejection must be (Withdrawn)
- II. The Teitelbaum Reference is not Analogous Art
- III. The Rejection fails to meet the *prima facie* requirements of establishing obviousness of the presently claimed invention.

***I. The Finality of the Rejection must be (Withdrawn)***

First – during the Examiner interview on 5 January 2006 referenced in the previous Amendment, the Examiner represented to the undersigned that he would not make this Rejection final in consideration of the arguments and positions raised during the interview. The Finality of this Rejection is contrary to this representation and should be withdrawn for this reason alone.

Second – the rejection under 35 USC Section 101 is not a new grounds of rejection necessitated by the amendment. Rather, the USPTO is attempting to assert changes to the patentability standards by changing the Examination Guidelines and it is this change at the USPTO that has resulted in the new Grounds of Rejection.

***II. The Teitelbaum Reference is not Analogous Art***

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TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE  
ANALOGOUS PRIOR ART

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

The rejection simply asserts that Teitelbaum is analogous art without demonstrating either that this reference is within the field of Applicant's endeavor or that it be reasonably pertinent to the particular problem with which the inventor was concerned. The undersigned respectfully asserts that neither is true. Teitelbaum deals with telephone units and for identification of a user of the telephone and as such, the reference would not commend itself to the inventor's attention in attempting to control gating power to a booting personal electronic device. Teitelbaum is not relevant simply because it uses a biometric reader – it must be relevant to the particular problem to be solved. As Teitelbaum does not mention power gating, power supply, boot sequences or the like, it cannot be considered

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relevant to the particular problem with which the inventor of the present invention was involved.

The undersigned respectfully requests withdrawal of the Teitelbaum reference as a reference.

***III. The Rejection fails to meet the prima facie requirements of establishing obviousness of the presently claimed invention.***

The rejection asserts that all claims are rejected under Section 103(a) as being unpatentable over a combination of Novikov et al. and Teitelbaum. Specifically:

Claim 1

The rejection simply states "Novikov et al." teach and describe a biometric controlled power gate controlling a power flow from a power source to an electrically powered device" and further asserts:

"a circuit of the device energized by the power flow for enabling a startup procedure of a processor of the device; a biometric-controlled switch; coupled to said circuit between the power source and said processor, for enabling said energizing of said circuit responsive to an assertion of a biometric activation signal" and then simply refers to a general discussion of the structure of the Novikov system ("col. 5 line 6 to col. 7 line 16") without detailing or showing correspondence of these elements or how the claim language is satisfied. For example, the rejection fails to disclose what circuit is energized, how this circuit enables a startup procedure of a processor of the device or what the device is or what startup procedure. The "power flow" referenced in this limitation is from a power source to the device, the circuit is a power gate to this device. The rejection fails to show proper correspondence of the elements of this circuit, to which the other elements of the claim are related.

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The rejection of claim 1 with respect to Novikov et al. concludes "although the system disclosed by Novikov shows all features of the claimed limitation, but Novikov does not specifically disclose gating functionality using biometric Novikov biometric controlled switch." The undersigned acknowledges this limitation of Novikov et al., in addition to at least the other limitations noted above.

To satisfy this acknowledged deficiency, the rejection asserts an non-analogous reference (see discussion above) that simply teaches use of a biometric system with a telephone.

The rejection asserts that Teitelbaum provides "biometric data to a switch for establishing a communication link, such as start and stop of access control, between at least a user and the at least a device user is trying to access, and thus providing features and enabling services in dependence upon received biometric data" referencing col. 2, line 42 to line 52.

The rejection concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Novikov et al. and Teitelbaum, because Teitelbaum's method of controlling a switch using biometric input by using directly connection would not only promote security structure in the system of Novikov during startup of a device and access control but will also provide safeguards against attempt by unauthorized person to breach security of system" – referencing col. 1 line 65 to col. 2, line 5).

First, as noted above, the Teitelbaum reference is respectfully asserted to be non-analogous and therefore the undersigned respectfully asserts that all the rejections relying on Teitelbaum (the Section 103(a) rejections of claims 1–49) be withdrawn.

Second, even assuming *arguendo* that the Teitelbaum reference is analogous art, it fails to offer anything new or missing or required or valuable to Novikov et al.,

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contrary to the assertions of the rejection. Teitelbaum simply teaches use of a biometric reader in cooperation with a telephone to send biometric information to either a central switch of a telephone company or to another telephone device through such a central switch. The biometric reader of Teitelbaum is simply used as a conventional biometric reader to convey biometric data to a processing system to evaluate access, just like Novikov et al. Novikov et al. is not concerned at all with telephonic communications, exchanging personal data, encryption or the like as asserted by the rejection and Teitelbaum does not concern itself with PC issues addressed by Novikov et al.

Third, the rejection mischaracterizes the Teitelbaum reference in suggesting any correspondence between a switch as used in the power gating context and a telephone company central office switch as used in Teitelbaum. In the field of telecommunications, a telephone exchange or telephone switch is a system of electronic components that connects telephone calls. A central office is the physical building used to operate telecommunications equipment. Telephone switches are what make phone calls "work" in the sense of making connections and relaying the speech information. There is no suggestion in Teitelbaum that the biometric data from the telephone controls, influences, or is in any way involved with a power boot sequence of the telephone systems, switches or any other device of the central office. In fact, for the Teitelbaum invention to work at all, the central switches must be up and enabled and fully operational before any telephonic exchange is possible – thus Teitelbaum cannot be relevant to power gating.

Fourth, even given the limitations of the first three arguments noted above, the combination of Novikov et al. and Teitelbaum still fail to meet all the limitations of the claimed invention.

None of the references, nor does the rejection explain the absence of correspondence, of a circuit that enables a startup procedure of the device as expressly recited in claim 1. The rejection does not cite any discussion in Novikov et al. or Teitelbaum of a startup procedure relevant specifically to the rejection of claim 1. With

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electronic devices, particularly those with processors, it is common to have a startup procedure (e.g., boot) and the undersigned readily acknowledges that it is likely that the PC disclosed in Novikov et al. has such a circuit. However, this circuit is central in relationship to other elements and the Novikov is silent as to this circuit as well as to any interrelationship of this circuit to other elements of the Novikov et al. invention. Specifically, Novikov et al. is clearly and unambiguously related to using the PC in cooperation with the biometric reader and as such the biometric reader and other elements do not influence the startup of the PC. The same is true of Teitelbaum – the telephone and the central office switches are all powered on and active in order to even use the biometric readers.

These systems are less secure than the present invention as they require software access control and other post-power up solutions to attempt to limit access which is less reliable than the present invention at controlling access. Conventional systems relying on post-power solutions even now, much more so when the present invention was made, are susceptible to defeat and work-arounds, often using the processor as an aid in defeating or working around. The present invention provides a fundamental solution not taught or suggested in the either of the cited references.

And specifically not taught or suggested, is an express limitation in claim 1: "...wherein the device is inoperable from the power source until said assertion of said biometric activation signal." Without specific explanation from the rejection of explaining just what device, what power source, and what circuit in the cited references satisfy these limitations, the undersigned is unable to refute the rejection in more detail. However, a text search of the references does not find "power source" used in Novikov et al. and one reference in Teitelbaum (with respect to Fig. 5 discussing that the biometric reader (as opposed to the telephone) is powered from the telephone line or from a separate power source. No mention is made of interrupting a power source (or gating the power) that controls the PC (Novikov et al.) or the telephone (Teitelbaum) so that either device is inoperable until an assertion of the biometric activation signal. In fact, it appears that the mouse or external biometric scanner is itself powered from the PC, thus the

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scanner/reader is inoperable itself prior to the completion and activation of the boot sequence. And therefore, the reader is incapable of participating in the boot/startup procedure of the device. For these reasons alone, the undersigned respectfully requests withdrawal of the rejection of claim 1 under Section 103(a) based upon Novikov et al. and Teitelbaum.

For all the reasons set forth above, claim 1 is respectfully asserted to be allowable over the cited references.

### Claim 2

The rejection of claim 2 based upon Novikov et al. fails to present a *prima facie* case of obviousness. The rejection fails to explain how this reference teaches: 1) an interposition of a biometric controlled switch 2) between a power source and a 3) circuit of the electronic device for 4) enabling a startup procedure such that the biometric switch 5) interrupts power to said circuit when 6) the activation signal is not asserted and 7) wherein said startup procedure is inoperable from the power source until 8) said assertion of said biometric activation signal.

None of the 1) – 8) express elements of claim 2 are explained by the rejection – the cited portions simply explain conventional operation of a biometric scanner to read a fingerprint and to make a determination of whether a use is granted access to a computer/network resource. In Novikov et al., the PC is involved in the scanning, processing, and decision tree and as such, the reference fails to satisfy any of the eight limitations. It appears that the mouse or external biometric scanner is itself powered from the PC, thus the scanner/reader is inoperable itself prior to the completion and activation of the boot sequence. And therefore, the reader is incapable of participating in the boot/startup procedure of the device as expressly recited in the claims.



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For all the reasons set forth above, claim 2 is respectfully asserted to be allowable over the cited references.

Claim 3

Due to the similarities of claim 3 to claims 1 and 2, and the rejection's assertion of unpatentability based upon Novikov et al., claim is respectfully asserted to be insufficient for the reasons set forth above in discussing the patentability of claims 1 and 2.

For all the reasons set forth above, claim 3 is respectfully asserted to be allowable over the cited references.

Claims 4–23

Claims 4–23, directly or indirectly dependent from claim 3, are all respectfully asserted to be patentable for at least the reasons set forth above in the discussion of the patentability of claims 1–3.

Additionally,

Claims 6–8 recite specifics about the type of device (portable, PDA, and laptop device). The rejection asserts that these limitations are found in col. 1, line 53 to line 57. That section of the Novikov et al. reference states: "An object of the present invention is also to provide a biometric based access control system for use on computers which permits a user to graphically apply biometric access control features to data and applications by the use of a usermanipulated biometric protection icon."

No reference to portable devices, PDA, or laptop devices as asserted by the rejection. The rejection of claims 6–8 must be withdrawn for this additional reason.

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Claims 9–11 recite specifics about the power source. Since the rejection fails to show how the power source, as expressly claimed, is satisfied by the Novikov et al. reference, the rejection fails to explain how the expressly recited specifics are also satisfied. Specifically, these claims discuss a power supply, a battery, and a direct power source. The cited section of the Novikov et al. reference states: “A serial port interface, that is, a COM port interface, functioning at 115.2 KB may be effected using a processor in the interface unit 162, such as an Atmel AT29C2051, and an RS232 voltage converter. In such an instance the interface unit 162 is optionally incorporated in a connector for connecting the input cord 72 to the computer’s 50 serial port. Power is supplied from the computer 50 via a further connector and is processed by the voltage converter to drive the computer mouse 50.”

No mention of a battery, or other power source for the computer – this section mentions power for the biometric reader as noted above. The rejection of claims 9–11 must be withdrawn for this additional reason.

Claims 12–17 recite specifics about the biometric-controlled switch. Since the rejection fails to show correspondence of the claimed switch with Novikov et al., as expressly claimed, the rejection fails to explain how the expressly recited specifics of the switch are satisfied. Specifically, these claims discuss a integration and operation of the biometric switch. The cited section of the Novikov et al. reference states: “The biometric input device 54 is connected to the computer 50 via an input cord 72. Alternatively, depending upon the type of port the biometric input device 54 uses to communicate with the computer 50, an embodiment of the present invention has a port adaptor connector 57 connecting the input cord 72 to a corresponding port on the computer 50. A still further alternative provides an embodiment of the present invention wherein a standalone adaptor unit 58 channels data via the input cord 72 and a cable 59 to and from the computer 50.”

Claim 12 recites that the switch is integrated into the electronic device and the cited portion of the rejection discusses that the biometric reader is external to the PC, not

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integrated. If the rejection asserts that the electronic device is the biometric reader, then the rejection fails for many other reasons than those noted above as the discussion suggests that the rejection considers the PC to be the corresponding electronic device of the claims.

Claim 13 integrates this switch into the power source – the rejection and the reference fail to teach this limitation, particularly because the biometric switch as recited in claim 3 is not taught or suggested. There is no mention in the rejection or in the reference of integrating this function into a power source.

Claim 14 integrates the switch into the biometric reader – the rejection and the reference fail to expressly teach this limitation, particularly because the biometric switch as recited in claim 3 is not taught or suggested. There is no mention in the rejection or in the reference of integrating this function into a power source.

Claim 15 defines the switch as a state device for storing an operational mode – the rejection and the reference fail to expressly teach this limitation, particularly because the biometric switch as recited in claim 3 is not taught or suggested. There is no mention in the rejection or in the reference of having this function be a state device or that it store an operational mode.

Claim 16, dependent from claim 15, is patentable for the reasons set forth above with respect to claim 15, and additionally it is patentable in its own right. Claim 16 recites that the state device maintains gating after receiving an asserted activation signal. The cited portions of Novikov et al. (col. 8, lines 8–60) do not discuss such a feature or function.

Claim 17, dependent from claim 16, is patentable for the reasons set forth above with respect to claim 16, and additionally it is patentable in its own right. Claim 17 recites that the state device is reset to disable the power from the power source when the

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electronic device is inactivated pending reassertion of the activation signal. The cited portions of Novikov et al. (col. 5, lines 33–42) do not discuss such a feature or function.

The rejections of claims 12–17 must be withdrawn for these additional reasons.

Claims 18–20 recite specifics about BIOS routines of the electronic device. Specifically, these claims discuss features and operation of the electronic device through details of the BIOS. The cited section of the Novikov et al. reference is to FIG. 1, items 50, 54, and 57. Item 50 is a computer, item 54 is a biometric input device, and item 57 is a port adapter connector. The word “BIOS” is not used anywhere in Novikov et al. Computer 54 is likely to have had a BIOS routine, however claim 18 expressly recites a relationship between a biometric controlled switch and these BIOS routines. The rejection simply seems to suggest the claimed relationship exists between the Novikov et al. reference and these claims because high level elements exist – the simple fact that Novikov et al. has a PC (which may contain BIOS routines) and a biometric reader and connector coupling these devices together does not teach or suggest that the claimed switch selectively activates one or more of the BIOS routines responsive to said activation signal as recited in claim 18.

Claim 19, dependent from claim 18, asserts a multiple user scenario with the biometric reader (as set forth in claim 18 and claim 3) discriminating between different users.

Claim 20, dependent from claim 18, asserts that a different BIOS routine is used for different users. No teaching or mention of this feature is taught or suggested in the teachings of Novikov et al.

The rejections of claims 18–20 must be withdrawn for these additional reasons.

Claims 24 and 25

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Independent claim 24, similar to independent claims 1–3, recite an affirmative power gating using a biometric switch “wherein said electronic device is inoperable from said power source until said assertion of said biometric activation signal and wherein said biometric access control is disposed between said power source and said electronic device to control said power therethrough.” As noted and discussed/asserted/argued above, Novikov fails to teach these express limitations.

Claim 25, dependent from claim 24, is patentable for at least all the reasons set forth above in the discussion of claim 24. Claim 25 is patentable in its own right as it recites that the gating step d) of claim 24 operation enablement includes initiating a boot sequence of said electronic device. The rejection cites a discussion in Novikov et al. (col. 8, lines 8–25) as supporting this limitation. However, that discussion pertains only to the biometric reader and does not include any discussion of the boot sequence of the PC or control thereof.

The rejections of claims 18–20 must be withdrawn for these additional reasons.

#### Claims 26–46

Independent claim 26 is a method claim having limitations corresponding generally for purposes of this argument, to independent claim 3. Thus claim 26 is respectfully asserted to be patentable because of the operational issues expressly recited relating to recited structure fails to be taught or suggested by Novikov et al., particularly as the recited structure is missing or has different function/operation as noted above.

Dependent claims 27–46 (dependent directly or indirectly from claim 26) correspond in similar fashion to dependent claims 4–24 and thus these claims are respectfully asserted to be patentable for corresponding reasons as noted above.

Thus, the rejections of claims 26–46 is respectfully requested to be reconsidered and withdrawn in light of the comments made herein.

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### Claims 47-49

Independent claims 47-49 are, respectively, a computer product claim, a propagated signal claim, and means plus function claim. These claims are generally similar to the independent claims discussed above insofar as understanding express limitations and distinctions between these claims and the Novikov et al. reference, and the undersigned respectfully requests reconsideration and withdrawal of the rejection of these claims based upon Section 103(a).

### 35 USC Section 101 Rejections

The rejection asserts that both claim 47 (computer program product) and claim 48 (propagated signal claim) are non-statutory for the same reasons. The propriety of an *In Beauregard* claim to a computer program product is, in fact, not in doubt and supported by *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995) among other precedent. The case was dismissed and remanded to the PTO with the statement "the Commissioner now states that computer programs embodied in a tangible medium such as floppy diskettes are patent subject matter under 35 U.S.C. § 101." To the undersigned's knowledge, the new examination guidelines affect propagated signal claims (claim 48) but not computer program product claims (claim 47). Thus the rejection of at least claim 47 is in clear error and withdrawal is required.

With respect to claim 48, the propagated signal claim, the undersigned notes that the USPTO has changed its Examination guidelines to suggest that propagated signal claims are non-statutory and therefore acquiesces that this issue will be preserved for appeal unless the rejections of claims 1-47 and 49 are withdrawn and an indication of allowability made in which case claim 48 will be cancelled from this particular application, with applicant maintaining the right to resubmit the claim in a continuation application for the purposes of appealing the decision of the USPTO.

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In view of the above comments, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By /Michael E. Woods/  
Michael E. Woods  
Registration No.: 33,466  
PATENT LAW OFFICES OF MICHAEL E.  
WOODS  
112 Barn Road  
Tiburon, California 94920-2602  
(415) 388-0830  
(415) 388-0860 (Fax)  
Attorney For Applicant